

### **REMARKS**

Reexamination and reconsideration of this application is respectfully requested in light of the foregoing amendments to the specification and claims, and the following remarks.

Claims 1-10 and 49 are pending in this application. Claims 11-48 have been canceled without prejudice or disclaimer. No new claims have been added.

Applicant notes the Examiner's consideration of the information cited in the Information Disclosure Statement filed January 14, 2005 as acknowledged in the Office Action Summary. Applicant further notes the Examiner's acceptance of the drawings filed on March 10, 2004.

### **Objections to the Specification**

The Examiner noted "informalities" in the specification and required correction thereof. Specifically, the Examiner noted informalities in paragraphs [0002], [0012], [0028], [0037], [0040], [0045], [0051], [0065], [0066] and [0077] of the specification. These informalities have been corrected and are set forth in the Amendments to the Specification section of this response (pages 3-7). The Examiner also noted a misspellings in the Abstract. The Abstract has been amended and the amendment is reflected in "Amendments to the Specification" on page 8 of this response. A clean copy of the revised Abstract is also attached.

### **Budapest Treaty Requirements**

The Examiner finds that the specification lacks deposit requirements for the deposit of *S. argillaceus* M7W1. The requirement for the mutant appears to only affect claim 48. The claim has been canceled without prejudice or disclaimer. As for the deposit of the parent strain on

page 1 of the specification (believed to be paragraph [0003]), the specification has been amended to include the address where the parent strain is deposited.

### **Rejections Under 35 U.S.C. § 112**

Claim 48 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in that the specification does not include a deposit ATCC number for *Streptomyces argillaceus* identified as M7W1. Claim 48 has been canceled, thereby rendering the rejection moot.

Claim 49 stands rejected under 35 U.S.C. § 112, first paragraph, as not being enabling for pharmaceutical compositions of the compounds set forth in claims 1 and 6-10. Applicant respectively traverses this rejection.

The test of enablement is whether one skilled in the art could make or use the claimed invention from the disclosures in the specification coupled with information known in the art without undue experimentation. *United States V. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1046 (1989); *In re Stephens*, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976). Determining enablement is a question of law based on underlying factual findings. *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); *Atlas Powder Co. v. E.I. Du Pont De Nemours & Co.*, 750 F.2d 1569, 1573, 224 USPQ 409, 411 (Fed. Cir. 1984).

The specification outlines pharmaceutical composition formulations in paragraphs [0066] to [0080]. The preparation of such formulations would be within the skill of the art. The Office Action does not set forth any evidence that preparing a pharmaceutical composition of the compounds of claims 1 and 6-10 would require undue experimentation by a person skilled in the

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art. For the foregoing reasons, it is respectfully requested that the rejection be reconsidered and withdrawn.

### **Conclusion**

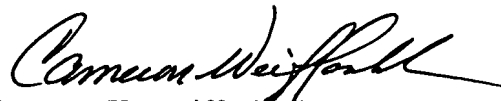
For the foregoing reasons, favorable reconsideration of claims 1-10 and 49 is requested in light of the preceding amendments and remarks. Allowance of the claims is courteously solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's attorney at the telephone number shown below.

A petition for a two-month extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. § 1.17 and due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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